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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,342	04/11/2006	Jean-Francois Stumbe	288261US0PCT	3536

22850 7590 06/15/2009  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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DOLLINGER, MICHAEL M

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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06/15/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,342	<b>Applicant(s)</b> STUMBE ET AL.	
	<b>Examiner</b> MICHAEL DOLLINGER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-4 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. The following Election of Species was already presented to the Applicant in the office action of 11 February 2009 but an election of an ultimate species was not made. The arguments presented by Applicant in response to the first office action are addressed below.

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

**Applicant must choose one species (1) through (14), listed below, of the at least one compound having at least one ethylenic double bond. If species of (1) is elected, then Applicant must choose one of the following species (2)-(14) that falls within the genus of (1). The species are as follows:**

(1) compound having a terminal double bond,

(2) compound of formula Ia

(3) compound of formula Ib

**If species (2) or (3) is chosen, Applicant must pick one species of each of the following**

i) R<sup>1</sup> must be selected from a) branched or unbranched C<sub>1</sub>-C<sub>10</sub> alkyl or b) hydrogen

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- ii)  $R^2$  must be selected from a) branched or unbranched  $C_1-C_{10}$  alkyl, b)  $C_2-C_6$  alkenyl, c)  $COOH$  or d) hydrogen
- iii)  $X$  must be selected from a) halogen or b)  $OR^3$
- iv)  $R^3$  must be selected from a) branched or unbranched  $C_1-C_{10}$  alkyl with at least one functional group, b) polyethylene glycol derivatives and polypropylene glycol derivatives, c) glycidyl, d)  $H-CO$  (formyl), e) branched and unbranched  $C_1-C_{10}$  alkyl- $CO$  and f)  $C_6-C_{10}$  aryl- $CO$
- (4) unsaturated carboxylic acids having 3 to 30 carbon atoms and from 1 to 5  $C=C$  double bonds
- (5) unsaturated alcohols having 3 to 40 carbon atoms and from 1 to 5  $C=C$  double bonds
- (6) unsaturated amines having 3 to 20 carbon atoms and from 1 to 5  $C=C$  double bonds
- (7) diol and polyol ethers in which at least one hydroxyl group is etherified with an unsaturated alcohol and at least one hydroxyl group is unetherified
- (8) diol and polyol esters in which at least one hydroxyl group is esterified with an unsaturated acid and at least one hydroxyl group is unesterified
- (9) vinyl esters
- (10) diene monoepoxides
- (11) triene monoepoxides
- (12) unsaturated halides having 2 to 20 carbon atoms and from 1 to 5  $C=C$  double bonds

(13) isocyanato (meth)acrylates

(14) unsaturated halogenated silanes

**If species (4), (5), (6) or (12) is chosen, Applicant must specify the number of double bonds present.**

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The claims are deemed to correspond to the species listed above in the following manner:

Species (1) corresponds to claim 2

Species (2) and (3) correspond to claim 3

Species (4) through (14) correspond to claim 4

The following claim(s) are generic: 1 and 5-9.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The common

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technical feature of the claims cannot be special because it is disclosed in the prior art.

The common technical feature of the claims hyperbranched polyester obtainable by reacting (c) at least one compound having at least one ethylenic double bond with at least one hyperbranched polyester obtainable by condensing; (a) at least one dicarboxylic acid or derivative thereof with at least one at least trifunctional alcohol; or (b) at least one tricarboxylic or higher polycarboxylic acid or derivative thereof with at least one diol. Raanby et al (US 5,834,118) disclose a radiation curable resin comprising a hyperbranched polyester wherein the polyester is obtained (a) reacting an aromatic polycarboxylic anhydride with 2 to 4 carboxyl groups with a polyol with 3 to 10 reactive hydroxyl groups (corresponding to the claimed step (a)) and (b) reacting the product of (a) with glycidyl (meth)acrylate (corresponding to the claimed step (c)) [column 3 lines 5-20]. Henceforth Raanby et al disclose the common technical feature of the claims and the present claims lack unity of invention.

### ***Response to Arguments***

5. Applicant's arguments filed 03/13/2009 have been fully considered but they are not persuasive. It appears as though Applicant's have responded to the requirement for Election of Species as though it were a requirement for restriction. To be clear, Examiner is requiring an election of species and not requiring a restriction.

6. Applicant argues that Examiner has not met the burden of proof in explaining why each group of inventions is patentably distinct from the other or in establishing lack of unity of invention. This is not convincing because Examiner has put forth an

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argument for the lack of unity of the present claims that was presented in the previous office action and is repeated in paragraph 4 above in this office action.

7. Applicant also argues that the Examiner has not considered that the claims are considered related invention under 37 CFR § 1.4758(b) in which the combination of (3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product will be considered to have unity of invention. This argument is not convincing because the aforementioned groups of claims are not being restricted apart. Rather, patentably distinct species within these claims are the subject of the requirement of election of species.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on Monday - Thursday 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

MICHAEL DOLLINGER  
Examiner  
Art Unit 1796

/mmd/